

REMARKS

Upon entry of the present amendment, the claims remaining in the application for consideration are amended are amended claims 19 and 27, and previously presented claims 20-26 and 28-34.

THE CLAIM REJECTIONS UNDER 35 USC § 103.

The last OA rejected previous claims 19, 21, 27, and 29 under 35 USC 103(a) as allegedly being unpatentable under Gelfer et al. in view of Leupold.

In addition, the last OA rejected previous claims 20, 22-26, 28, and 30-34 under 35 USC 103(a) as allegedly being unpatentable under Gelfer et al. in view of Leupold as applied to previous claims 19, 21, 27, and 29 above, and further in view of Yoneda et al.

Applicant respectfully requests reconsideration of these rejections, as now applicable to the currently amended claims, for the following reasons.

(1) There is no justification in Gelfer et al. and Leupold, or in any other prior art separate from applicant's disclosure, which suggests that these references be combined, much less be combined in the manner proposed in the last OA.

(2) There is no justification in Gelfer et al. and Leupold and Yoneda et al., or any other prior art separate from applicant's disclosure which suggests that these references be combined, much less be combined in the manner proposed in the last OA.

(3) The proposed combinations would not be physically possible nor operative.

(4) Even if Gelfer et al. and Leupold were to be combined in the manner proposed, the proposed combination would not show all of the novel physical features of applicant's claims 19 (currently amended), 21, 27 (currently amended), and 29.

(5) Even if Gelfer et al. and Leupold and Yoneda et al. were to be combined in the manner proposed, the proposed combination would not show all of the novel physical features of applicant's claims 20, 22-26, 28, and 30-34.

(6) The results achieved by applicant's invention are superior and unsuggested by the applied references.

(7) Up to now, those skilled in the art thought or were skeptical that the techniques used in applicant's invention were unworkable or presented an insuperable barrier.

(8) Up to now, those skilled in the art thought or found the problem solved by applicant's invention was insoluble, that is, the invention converts failure into success. The failures of prior art workers indicate that a solution was not obvious.

(9) Applicant's invention is classified in a crowded art. Therefore, a small step forward should be considered significant.

(10) The prior art lacks any suggestion that the references should be modified or combined in a manner required to meet the claims.

(11) The references do not teach what the last OA relies upon them supposedly teaching.

(12) Applicant's invention solves a long-felt, long-existing, but unsolved need.

(13) The last OA has made a strained interpretation of the references that could be made only by hindsight.

(14) Applicant's invention solves a different problem than the problems addressed by the three applied references.

(15) The last OA does not present a convincing line of reasoning as to why the claimed subject matter as a whole, including its differences over the prior art, would have been obvious.

(16) The prior art references do not contain any suggestion (expressed or implied) that they be combined, or that they be combined in the manner suggested.

(17) Each reference is complete and functional in itself, so there would be no reason to use parts from or add or substitute parts to any reference.

(18) The references take mutually exclusive paths and reach different solutions to solve different problems. Since they teach away from each other, it would not be logical to combine them.

(19) The references themselves teach away from the suggested combinations.

(20) The references are from different technical fields than that of the invention, that is, they are from non-analogous art.

(21) Those skilled in the art would find it physically impossible to combine the references in the manner suggested.

(22) If combined, the references would produce an inoperative combinations.

(23) It would be necessary to make modifications, not taught in the prior art, to combine the references.

(24) Even if combined, the references would not meet the claims.

(25) The combinations suggested requires a series of separate, awkward combinative steps that are too involved to be considered obvious.

(26) The fact that three references must be combined to allegedly meet claims 20, 22-26, 28 and 30-34 is evidence of unobviousness.

The last OA states that Gelfer teaches a body treatment pad having a flexible base member 10 made of plastic material with a plurality of needles 14, 15 each having a base end and a tip 17. The last OA further states that it is inherent that the base member has a certain degree of elasticity.

Applicant respectfully submits that applicant's claims relate to "A device for reflexotherapy".

Applicant's specification explains that "The present invention relates to devices using in physiotherapy with the aim of stimulating reflex points on the surface of the human body, and particularly to applicators, and may be used both at medical institutions and under home conditions for practicing reflexotherapy." Specification page 1, first paragraph.

In contrast, the Gelfer et al. "invention relates to an acupuncture treatment device comprising a flexible pad adapted to be pressed against a person's skin to stimulate blood circulation and safely relieve pain caused by stress, exercise or accident." Gelfer et al., column 1, lines 8-12.

In view of the foregoing, it is quite understandable why the last OA does not allege that Gelfer et al discloses "A device for reflexotherapy" as claimed by applicant.

Applicant's currently amended claim 19 further requires, "an elastic base member being in plasticized condition in the course of heating, and being an integral structure upon curing; and needles provided each with one squeezed thickened end and one sharpened end, said squeezed thickened ends being embedded in said elastic base member when in said plasticized condition so that upon curing of said elastic base member at least said squeezed thickened end of each needle is squeezed in said integral structure of said elastic base member, and said remaining sharp end of each needle protrudes from said integral structure."

The last OA concedes that Gelfer does not disclose the increased thickness end being located inside of the base member. The last OA states however, Leupold teaches that a needle 8 may be embedded in a base material (see Fig. 3).

The last OA further states that it would have been obvious to one skilled in the art to embed the needles of Gelfer within the base as taught by Leupold, if one wished to further stabilize the anchoring of the needles to the base, to help prevent the needles from breaking off.

It is respectfully submitted that Gelfer does not disclose, and the last OA does not allege that Gelfer discloses, "A device for reflexotherapy, comprising: an elastic base member being in plasticized condition in the course of heating, and being an integral structure upon curing;..." as set forth in currently amended claim 19.

It is respectfully submitted that it would be misleading to state that Gelfer discloses "A device for reflexotherapy, comprising: an elastic base member being in plasticized condition in the course of heating, and being an integral structure upon curing...."

In contrast, Gelfer disclose a flexible backing sheet 10 which can be canvas, or heavy cloth, or a thin sheet of non-woven plastic material; a prime consideration is that the sheet have sufficient flexibility to conform to a person's body, (e.g. wrapped around a person's arm, or lying against a person's back). Gelfer, column 3, lines 5-12.

In addition, it is respectfully submitted that Gelfer in view of Leupold does not make obvious:

"A device for reflexotherapy", nor

"an elastic base member being in plasticized condition in the course of heating, and being an integral structure upon curing"; nor

"needles provided each with one squeezed thickened end and one sharpened end"; nor

"said squeezed thickened ends being embedded in said elastic base member when in said plasticized condition so that upon curing of said base member at least said squeezed thickened end of each needle is squeezed in said integral structure of said base member"; nor

"said remaining sharpened end of each needle protrudes from said integral structure";
as specified by applicant's currently amended claim 19.

With regard to the statement in the last OA that Gelfer does not disclose the increased thickness end being located inside of the base member, applicant respectfully submits that Gelfer does not even disclose that any portion of the needle is located inside of the base member.

The alleged flexible base member 10 of Gelfer as alluded to in the last OA does not even contact any of the Gelfer needles 14, 15. In contrast, the Gelfer protuberances 14 and 15 are provided in rigid blocks 11, which in turn are affixed to one face of the backing sheet 10 by rivets 13. Gelfer, column 3, lines 4-53.

Applicant respectfully submits that the combination of Gelfer and Leupold as suggested by the last OA would not be obvious to the artisan, but more importantly, applicant does not claim an acupuncture device, nor a preshaped part 8 embedded in a finger ring 1 having a slit 2, as disclosed by Leupold.

Furthermore, applicant respectfully submits that the cited references, taken singly or in combination, fail to disclose or make obvious "A device for reflexotherapy, comprising ... at least said squeezed thickened end of each needle is squeezed in said elastic base member", as specified by currently amended claim 19.

It should be noted that Leupold teaches away from the applicant's claimed invention. For example, Leupold teaches a ring-shaped holder having means defining a rigid pressure plate. Leupold, column 4, lines 3-5.

Gelfer et al. relates to an acupuncture device, classified in International Class A61B 17/34.

Leupold relates to an acupuncture device, also classified in International Class A61B 17/34.

In contrast, applicant's invention relates to a reflexotherapy device, which is not classified in any of the subclasses of the applied art. Applicant's invention is classified in International Class A61H 39/00, 15/00, 39/08.

Applicant respectfully submits that the applied references, combined as suggested by the last OA, are from different technical fields (acupuncture) than that of applicant's invention (reflexotherapy), that is, they are from non-analogous art.

But more importantly, applicant respectfully submits that Gelfer et al. and Leupold do not contain any justification to support their combination, much less in the manner proposed.

With regard to the proposed combination of Gelfer et al. and Leupold, it is well known that in order for any prior-art references themselves to be validly combined for use in a prior art § 103 rejection, *the references themselves* (or some other prior art) must suggest that they be combined. E.g., as was stated in In re Sernaker, 217 U.S.P.Q. 1,6 (C.A.F.C. 1983):

“[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings”.

That the suggestion to combine the references should not come from applicant was forcefully stated in Orthopedic Equipment Co. v. United States, 217 U.S. P.Q. 193, 199 (C.A.F.C. 1983):

“It is wrong to use the patent in suit [here the patent application] as a guide through the maze of prior art references, combining the right references in the right way to achieve the result of the claims in suit [here the claims pending]. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law [here the PTO]”.

As was further stated in Uniroyal, Inc. v Rudkin-Wiley Corp., 5 U.S.P.Q. 2d 2434 (C.A.F.C. 1988) “[w]here prior art references require selective combination by the court to render obvious a

subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself...*Something in the prior art must suggest the desirability and thus the obviousness of making the combination.*" [Emphasis supplied].

In line with these decisions, the Board stated in Ex parte Levengood, 28 U.S.P.Q. 2d 1300 (P.T.O.B.A.&I. 1993):

"In order to establish a *prima facie* case of obviousness, it is necessary for the examiner to present *evidence*, preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art *would have been led* to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention...That which is within the capabilities of one skilled in the art is not synonymous with obviousness...That one can *reconstruct* and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention... Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in that art, that 'would lead' that individual 'to combine the relevant teachings of the references.' ...Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done."

In the present case, there is no reason given in the last OA to support the proposed combination, other than the statement "It would have been obvious to one having ordinary skill in

the art to embed the needles of Gelfer within the base, as taught by Leupold, if one wished to further stabilize the anchoring of the needles to the base, to help prevent the needles from breaking off".

However, the fact that the applied references each teach features aimed at solving different problems is not sufficient to gratuitously and selectively substitute parts of one reference (Leupold) for a part of another reference (Gelfer) in order to meet applicants' novel claimed combination.

In view of the foregoing, it is respectfully submitted that currently amended claim 19 is patentable over Gelfer et al in view of Leupold.

The foregoing applies with greater force to claim 21, which depends from currently amended claim 19 and defines a more limited species of the claim 19 invention.

The foregoing distinctions apply with even greater force to currently amended independent claim 27, which further distinguishes over the combination of Gelfer et al. and Leupold.

In particular, Gelfer in view of Leupold fails to make obvious:

"A device for reflexotherapy"; nor

"an elastic base member consisting of two layers joined together in plasticized condition by heating, and forming an integral structure upon curing"; nor

"needles provided with one squeezed thickened end and one sharpened end each"; nor

"at least said sharpened end of each needle passing through an upper layer of said two layers of said elastic base member and protruding therefrom"; nor

"said squeezed thickened end of each needle being disposed between said two layers and joined together with said two layers"; nor

"at least said squeezed thickened end of said needle being squeezed within said integral structure"; nor

“said squeezed thickened ends being fastened substantially in an area of joint between said two layers”,

as required by currently amended independent claim 27.

In view of the foregoing, applicant respectfully submits that currently amended claim 27 is patentable over Gelfer et al. in view of Leupold.

It is respectfully submitted that the foregoing applies with even greater force to claim 29, which depends from currently amended independent claim 27 and defines a more limited species of the claim 27 invention.

With regard to claims 20, 22-26, 28, and 30-34, the last OA concedes that the device of Gelfer as modified by Leupold does not disclose lugs on the bases of the needles, that are enveloped by the base member.

However, the last OA states that Yoneda et al. discloses a cone or trapezoidal shaped needle (fig. 2 and 6) that could be modified in the form of a nail shaped needle 12 which includes an increased thickness 15, with a lug 13.

The last OA further states that it would have been obvious to one skilled in the art to modify the needle of Gelfer et al as modified by Leupold to have a lug at the bottom, as taught by Yoneda, in view of Yoneda's teaching that such a lug allows for increased retention of the needle.

Applicant respectfully traverses these contentions based on the foregoing distinctions specified hereinabove, and the following additional distinctions.

Applicant agrees with the statement in the last OA to the effect that the device of Gelfer et al as modified by Leupold does not disclose lugs on the bases of the needles, that are enveloped by the base member.

However, in addition, the device of Gelfer as modified by Leupold also does not disclose needles having a squeezed thickened end squeezed in the integral structure of an elastic base member, nor an elastic base member consisting of two layers joined together in plasticized condition by heating and forming an integral structure upon curing.

Furthermore, applicant respectfully traverses the contention that Yoneda discloses a cone or trapezoidal shaped needle (figs 2 and 6) that could be modified in the form of a nail shaped needle 12 which includes an increased thickness 15, with a lug 13.

Yoneda Fig. 2 does not disclose a cone shaped needle. In contrast, Yoneda Fig. 2 discloses an acute projection 2 which has a through hole to pierce a needle for acupuncture, and the top of the needle is projected over the acute projection 2.

It is respectfully submitted that Yoneda Fig. 6 does not disclose a trapezoidal shaped needle. In contrast, Yoneda Fig. 6 discloses an acute pyramidal salient 8 having a through hole to pierce a needle for acupuncture, and the top of the needle is projected over the pyramidal salient 8.

Applicant respectfully submits that the applied references, combined as suggested by the last OA, are from very different technical fields (acupuncture) than that of applicant's invention (reflexotherapy), that is, they are from non-analogous art.

Gelfer et al., Leupold, and Yoneda do not contain any justification to support their combination, much less in the manner proposed.

With regard to the proposed combination of Gelfer et al., Leupold and Yoneda, it is well known that in order for any prior-art references themselves to be validly combined for use in a prior art § 103 rejection, *the references themselves* (or some other prior art) must suggest that they be combined. E.g., as was stated in In re Sernaker, 217 U.S.P.Q. 1,6 (C.A.F.C. 1983):

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In line with these decisions, the Board stated in Ex parte Levensgood, 28 U.S.P.Q. 2d 1300 (P.T.O.B.A.&I. 1993):

“In order to establish a *prima facie* case of obviousness, it is necessary for the examiner to present *evidence*, preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art *would have been led* to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention...That which is within the capabilities of one skilled in the art is not synonymous with obviousness...That one can *reconstruct* and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not

afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention... Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in that art, that 'would lead' that individual 'to combine the relevant teachings of the references.' ...Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done."

In the present case, there is no reason given in the last OA to support the proposed combination, other than the statement "It would have been obvious to one skilled in the art to modify the needle of Gelfer et al as modified by Leupold to have a lug at the bottom, as taught by Yoneda, in view of Yoneda's teaching that such a lug allows for increased retention of the needle."

However, the fact that the applied references each teach features aimed at solving different problems is not sufficient to gratuitously and selectively substitute parts of one reference for a part of another reference in order to meet applicant's novel claimed combination.

As stated in the above Levengood case,

"That one can *reconstruct* and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention".

Applicant therefore submits that combining Gelfer et al., Leupold, and Yoneda is not legally justified and is therefore improper. Thus, applicant respectfully submits that the rejection on these references is also improper and should be withdrawn.

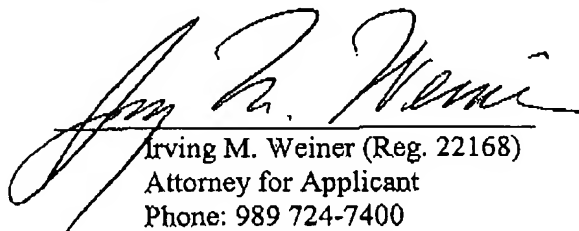
In view of the foregoing, applicant respectfully submits that the application is in condition for allowance, and a notice to this effect is earnestly solicited.

If the Examiner does not believe that the application is in condition for allowance, then it is respectfully requested that the Examiner promptly telephone the undersigned attorney for applicant in an effort to facilitate the prosecution, and/or to narrow the issues for appeal, if necessary.

Favorable reconsideration is respectfully requested.

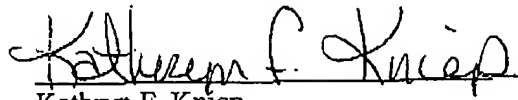
Respectfully submitted,

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Certificate of Mailing

I hereby certify that the foregoing Amendment-C, was sent by facsimile to Commissioner for Patents, Group Art Unit 3764, 703-306-3139 on August 3, 2004.


Kathryn F. Kniep